

REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, the specification has been amended to correct formal errors therein pointed out by the Examiner. Claim 2 and 10-13 have been amended to correct formal errors therein and to yet more clearly define the present invention.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

I. Objection to the Specification

The Examiner objected to the specification for formal error therein. As noted above, the specification has been amended to correct the noted formal errors.

With regard to the comment that the element “56” shown in Fig. 4 is not identified, it is noted that the specification defines the element “56” as “a thread (56) of the rear engagement member” (page 16, lines 10-11).

In view of the above, it is respectfully requested that the objections to the specification be withdrawn.

II. Objections to and Rejection of Claims

IIa. Objections to the Claims

The Examiner objected to claims 10-13 for formal errors therein. As noted above, claims 10-13 have been amended to eliminate the formal errors therein.

IIb. Rejection Under 35 U.S.C. §112

The Examiner rejected claim 2 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. It is respectfully submitted that the correction of the formal error in claim 2 overcomes the Examiner’s rejection of claim 2 for the alleged indefiniteness.

Iib. Rejection of Claims Over the Prior Art

The Examiner rejected Claim(s) 2 and 10-13 under 35 U.S. §103 (a) as being unpatentable over Hoffmann et al, U.S. Patent Publication No. 2002/0098057 (corresponds to U.S. Patent No. 6,632,058) in view of Tinnerman, U.S. Patent No. 2,096,387 (Tinnerman) and Simmons, U.S. Patent No. 2,328,587 (Simmons). Claims 5 and 12 were also as Claims above and further in view of Blessing et al., U.S. Patent No. 6,305,889 (Blessing), Fullerton U.S. Patent No. 4,378,187 (Fullerton), and Schertz, U.S. Patent No. 3,352,341.

It is respectfully submitted that claims 2, 5 and 10-13 are patentable over the cited references. Specifically, claim 10 recites:

- (i) an even wall section that abuts a wall of the inner cone along a substantially entire axial extent of the inner cone; and
- (ii) an annular middle portion that is formed by an offset that extends radially inwardly of the even wall section.

The foregoing novel features of the present invention are absent from Hoffmann (corresponds to DE 100 52 445 A1 discussed in the preamble of the specification). No are the novel features discussed above are disclosed in Simmons nor Tinnerman. Moreover, neither Simmons nor Tinnerman discloses a

quick mounting put having a housing in which a holding member is located, and for that reason alone are not believed to be particularly relevant to the present invention. Simmons discloses a fastener formed of a resilient metal wire without a holding section. Tinnerman relates to a fastener formed of a cold roll steel having the holding power of fasteners made from spring steel.

As discussed in the specification, the object of the present invention is to improve the Hoffmann nut so that a reliable connection of the nut with a threaded member is insured even upon displacement of the holding member within the nut housing. Neither Simmons nor Tinnerman can contribute to the solution of the problem the present invention solves. The choice of materials is not an object of the present invention.

It is respectfully submitted that the present invention, as defined in claim 10, would not be obvious over the combination of Hoffmann, Simmons, and Tinnerman.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must

be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983): SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP §2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggestion incentive or influence in the prior art, or in the form of generally available

knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. At 1301 (emphasis in original). As discussed, the choice of material is not an object of the present invention.

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. In re Jones 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Sponnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

It is respectfully submitted that obviousness of the present invention over the combination of Hoffmann, Simmons and Tinnerman can be gleaned only from a hindsight reconstruction.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

* * *

. . . it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

In Orthopedic Equipment Company, Inc. v. United States, 217 U.S.P.Q. 193-199 (Fed. Cir. 1983), the Federal Circuit warned:

The difficulty which attaches to all honest attempts to answer this question [of obviousness based upon a combination of prior art.] can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law

In view of the above, it is respectfully submitted that the present invention, as defined in Claim 10 would not be obvious over the combination of Hoffmann, Simmons, and Tinnerman and claim 10 is, therefore, allowable over said combination.

Claims 2-5 depend on Claim 10 and are also allowable.


Claims 11-13 also recite that the even wall section abuts the a wall of the inner cone along a substantially entire axial extent of the inner cone, and are allowable for the same reasons Claim 10 is allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects, in order to place in case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

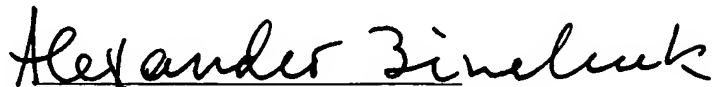


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on January 24, 2005.


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